REMARKS

Claims 1-8, 23-29, and 35-42 are pending, with claims 1, 3, and 23 being independent.

Claims 1, 3, and 23 have been amended. Claims 9-22 and 30-34 are canceled. No new matter

has been added. Reconsideration and allowance of the above-referenced application are

respectfully requested.

A.   Rejections Under 35 U.S.C. § 103

Claims 1, 3-7, 12, 14, 15, 17, 18, 23, 25, 36, 37, 39, 40, and 42 stand rejected under 35

U.SC. 103(a) as allegedly being unpatentable over Raciborski et al. (United States Publication

Number 20050132083) in view of Heath (United States Patent Number 6,006,034).

Claims 2, 13, 24, and 35 stand rejected under 35 U.SC. 103(a) as allegedly being

unpatentable over Raciborski et al. in view of Heath and in further view of Kano et al (United

States Publication Number 20030135650).

Claims 8, 19, 27, 38, and 41 stand rejected under 35 U.SC. 103(a) as allegedly being

unpatentable over Raciborski et al. in view of Heath and in further view of Hu (United States

Patent Number 5,586,260). It is not clear in paragraph 19 of the Office Action (see Page 8)

whether this same combination is also used by the Examiner to reject claims 5, 16, 26, 28, and 38

under 35 U.S.C. 103(a), or if the Examiner relies only the combination of Raciborski and Hu to

reject those claims. Clarification is requested.

Finally, Claim 29 stands rejected under 35 U.SC. 103(a) as allegedly being unpatentable

over Raciborski et al. in view of Tenerello (United States Patent Number 7,233,981.)

B.   The Amended Independent Claims Are Allowable

Amended independent claim 1 recites a method that includes, in part:

> subsequent to retrieving the document identifier, sending information
> specifying an acceptable authentication procedure, receiving an
> authentication procedure update request from the client, the
> authentication procedure update request associated with the electronic
> document, and obtaining, at the server and in response to the request, a
> software program comprising instructions operable to cause one or

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more data processing apparatus to perform operations effecting the
authentication procedure.

(Emphasis added.) The recited art taken alone or in combination fails to disclose or suggest the
method of claim 1.

Raciborski et al. describes a system that permits the downloading of multiple content
objects from web pages with a single click or selection. See Raciborski et al., Abstract, [0018],
and [0020]. In particular, Raciborski et al. describes a system in which a user can request a
group of content objects, and a download manager software with customized software is
downloaded to the user's computer. The downloaded manager software is unique to a particular
transaction session, and when executed at the user's computer downloads the content objects. Id.
at Figs. 4A-4E, paragraphs [0021]-[0023]. According to some embodiments, a transaction
identifier can be transmitted to the user and later used by the server to retrieved information
including content objects. Id. Additionally, according to some embodiments, an authentication
procedure can be implemented within the downloaded manager software to identify the user. Id.
at [0020], [0041], and Fig. 4D (step 444).

The Examiner relies on the transmission of the downloaded manager software in
Raciborski et al. to disclose, among other processes, retrieving a client request to take action with
respect to an electronic document *and* sending information specifying an acceptable
authentication procedure. In Raciborski customized software (i.e., the downloaded manager
software) includes instruction for an authentication procedure to identify the user. This same
customized software is used by the user's computer to retrieve electronic documents. Both
functions are embedded in the customized software such that an authentication procedure is not
specified in a subsequent communication or effected in a process subsequent to retrieval of the
request from the customized software. Upon execution of the customized software, the client
request and authentication procedure (if any exists) are received at a remote server.

The above-described authentication process of Raciborski is in stark contrast to the
claimed invention of amended independent claim 1, in which a determination is first made
whether an authentication procedure is necessary, and is implemented only subsequent to

receiving the client request. This is clearly distinguishable from the process facilitated by the customized program of Raciborski et al., which avoids multiple communications between the client and server to determine and implement authentication because the authentication process is embedded in the customized software which also requests content objects. See, e.g., Fig. 4D. Raciborski et al. fails to teach or disclose the invention of amended claim 1. Thus, claim 1 should be in condition for allowance for at least this reason.

As the Examiner admits on page 4 of the Office Action, Raciborski et al. also "does not teach a client requesting an authentication procedure update request." To satisfy this claimed process the Examiner attempts to rely on Heath. The Examiner states that Heath teaches an automatic application upgrade initiated at a client request, citing Col. 1, lines 55-65, and Col. 2, lines 1-15 and 46-50. The Examiner further contends that one of ordinary skill in the art would include the automatic application upgrade in Raciborski et al. to ensure that local client programs are current.

The Examiner is correct that Heath describes systems and methods for maintaining application programs on a client computer in a client-server network environment. See Heath at Abstract. According to Heath, version updating control of applications is shifted to individual client computers rather than a server, which is advantageous in an open network environment such as the Internet where servers cannot control remote clients. See Heath, Col. 1, lines 41- 47. An application program is stored on a server and a client, and upon use of the application program at the client the client can compare version identifications of the local stored copy with a downloaded catalog to the client that identifies the newest version of the application at the server. The client can download updates when versions do not match.

Claim 1 as amended, however, is distinguishable from Heath. As recited in the amended claim, the authentication procedure update request from the client and is <u>associated with the electronic document</u>. This is distinguishable from the Examiner's interpretation of Heath in which the authentication procedure update only occurs for <u>subsequent content object requests</u>. See Office Action, Page 4, lines 5-8. Although authentication updates are possible with Heath, they occur where *subsequent* content objects are requested. This is in contrast to amended

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independent claim 1, which states that the authentication procedure update is associated with the *same* electronic document associated with the request received at the server. Thus, an authentication procedure update occurring upon or after a subsequent content object request does not read on amended claim 1.

In addition to the failure of Raciborski et al. and Heath to disclosed the features of the amended claims, one of ordinary skill in the art would not combine Raciborski et al. and Heath. Heath is focused on updating client programs on the client device only after a comparison is made between the versions of a locally stored copy and a list of updated versions at a server. Raciborski et al., on the other hand, is focused on downloading material that is not stored on the client device. One of ordinary skill in the art would not combine the two references because the references achieve their results using an opposite approach from each other. Heath relies on client-side control of updates based only on version lists from a server (thus minimizing the role of the server), while Raciborski et al. relies on server downloads to client devices. The Examiner recognizes that this teaches away from the combination of Raciborski and Heath, but inappropriately justifies the combination by asserting that "because modifications to resident server programs are likely, which would then require an update to the client's software, such that the combined system requires that both remote and local programs are current." See Office Action, Page 4.

Raciborski et al. and Heath also fail to disclosure or teach the method and system of independent claims 3 and 23.

Independent claim 3 recites features similar to independent claim 1. For instance, only after a request is received at the server is an authentication program transmitted to the client for use in identifying a current user and controlling the action with respect to the electronic document. Additionally, the updated authentication procedure is an update procedure also associated with the same <u>electronic document</u>.

Independent claim 23 also recites features similar to independent claims 1 and 3, in the context of a system. For instance, only *after* the server receives a request is a software program

transmitted to the client that causes an authentication procedure to be performed. Additionally, claim 23 recites:

> wherein the client uses the authentication program to identify a current user and control the action with respect to the electronic document based on the current user and document-permissions information associated with the electronic document, _and wherein the action comprises an action taken with respect to the electronic document subsequent to opening the electronic document at the client_.

(Emphasis added.) On page 6 of the Office Action the Examiner states that the authentication procedure of Raciborski et al. can occur to permit an action of downloading an electronic document. The authentication program described by amended claim 23 is further distinguishable from Raciborski et al. and Heath because it can control an action taken by a user _subsequent_ to the opening of an electronic document.

For the reasons described above with respect to claim 1, Applicant requests allowance of claims 3, 23 and their dependent claims.

The remaining references of Kano et al., Hu, and Tenerello do not cure the noted deficiencies of Raciborski et al. and Heath. Thus, each of dependent claims 2, 4-8, 24-29, and 35-42 should be allowable based on their respective base claims and the additional recitations they contain. In addition, the rejections of the remaining claims have been obviated by the cancellation of the claims without prejudice. Thus, all of the now pending claims should be in condition for allowance, and a formal notice of allowance is respectfully requested.

C. Conclusion

The foregoing comments made with respect to the positions taken by the Examiner are not to be construed as acquiescence with other positions of the Examiner that have not been explicitly contested. Accordingly, the above arguments for patentability of a claim should not be construed as implying that there are not other valid reasons for patentability of that claim or other claims.

Please apply any excess claims fees, and any other necessary charges or credits, to

deposit account 06-1050.

Respectfully submitted,

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